

REMARKS

This paper is filed in response to the sixth non-final Office Action mailed August 5, 2008.

Summary of the Office Action

Claim 1 stands objected to.

Claims 1-15 and 17-28 are provisionally rejected under the non-statutory doctrine of obviousness-type double patenting.

Claims 1, 2, 5-15, 17-24, and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,149,622 (Marie) in view of U.S. Patent No. 5,496,270 (Nettekoven).

Claim 28 stands rejected under 35 U.S.C. § 103 as being unpatentable over Marie in view of Nettekoven and further in view of Norelli.

Claims 3, 4, 25, and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Marie in view of Nettekoven and further in view U.S. Patent No. 7,122,017 (Moutafis).

Summary of the Response to the Office Action

Applicants amend Claim 1, 14, 15 and 28.

Claims 1-15 and 17-28 remain pending.

The Objection to Claim 1

Applicants amend claim 1 to add a period, thereby obviating the objection. Claim 14 is amended to add the word "an." The amendment does not change the claim scope and Applicants do not intend to surrender any subject matter.

The Provisional Obviousness-Type Double Patenting Rejection

Claims 1-15 and 17-28 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting. Because this provisional rejection is asserted in the earlier filed application, the examiner should withdraw the provisional rejection and permit the present application to issue as a patent without a terminal disclaimer. *See MPEP § 804 I.A.1.*

The Rejection of Claims 1, 2, 5-14, and 27 Should Be Withdrawn

Applicants respectfully traverse the rejection of Claim 1 because the combination of Marie and Nettekoven lack each of the claimed features. In particular, Claim 1 recites a valve including “a removable fluid conduit having a first end for attaching to the aspiration cylinder and a second end for attaching to a cannula” and “a removable cap that connects the first and second housing portions.” This combination of features is not disclosed in Marie and Nettekoven, even if these two references were combined as proposed in the Office Action.

As a starting point, the Office Action does not allege that Nettekoven discloses a “removable cap” as recited in Claim 1. Instead, the Office Action relies upon Marie for this claimed feature. In particular, the Office Action attempts to equate the joining piece 30 of Marie to the “removable cap” recited in Claim 1. However, Marie does not disclose that the joining piece is removable. Rather, Marie discloses that the joining piece 30 and the end component 8 are joined by “the type of snap fitting that cannot be undone.” (Col. 3, lines 29-33.) As shown in Fig. 5, the snap fitting connection between joining piece 30 and end component 8 is made at the interior of these components and, thus, is inaccessible. Accordingly, the joining piece 30 cannot reasonably be considered a “removable cap,” as recited in Claim 1.

Further, the Examiner attempts to equate the “removable fluid conduit” to the end components 8, the longitudinal conduit 15, and the tubular connector 31 of Marie. However,

Marie does not teach or suggest that any of these elements are removable. In fact, connector 31 is part of the joining piece 30. (See Figs. 3 and 5; and col. 5, lines 31-33.) As noted above, the joining piece 30 is not properly considered removable.

Furthermore, Claim 1 recites the “removable fluid conduit” and the “removable cap” as separate elements. The Office Action alleges that the same structure – namely the joining piece 30, which includes the tubular connector 31 – is both the removable fluid conduit and the removable cap. The joining piece 30 of Marie cannot be both the fluid conduit and the cap of Claim 1. For at least these reasons, the combination of Marie and Nettekoven fails to disclose each of the features of Claim 1. For at least these reasons, the rejection of Claim 1 should be withdrawn.

Marie also teaches away from the combination proposed by the Examiner. Marie states that shells 3 and 4 are fitted together by “snap locking means 6 and 7”, which as shown in Figs 1 and 5 are provided on the inside of the device and thus are not accessible. (Col. 4, lines 50-53). It is apparent that once the shells 3 and 4 are locked together with no reasonable way to separate them. Moreover, as noted above, Marie indicates that the joining piece 30 and the end components 8 are joined with “the type of snap fitting which cannot be undone.” (Col. 3, lines 29-33; *see also*, col. 6, lines 39-41.) Thus, Marie teaches away from any design “that permits the interior of the housing to be accessed” as alleged in the Office Action.

Accordingly, the proposed combination of Marie and Nettekoven is not a “simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement, as alleged in the Office Action. (citations omitted.) Note that Marie was applied for and patented after Nettekoven. Thus, it cannot be considered a “piece of prior art ready for improvement” by the teachings of Nettekoven.

For at least the reasons discussed above, the rejection of Claim 1 should be withdrawn. Further, because the claims that depend from Claim 1 incorporate the features of Claim 1, the rejection of dependent claims 2, 5-14, and 27 should be withdrawn.

While Applicants do not acquiesce to the correctness of the rejections of the dependent claims, it is further noted that rejections of dependent Claims 6-8 are improper. The Office Action asserts that it would have been an obvious engineering choice to form the fluid conduit as a single piece and to make that single piece of resilient material, namely silicone. Applicants respectfully disagree. The Office Action asserts that the claimed “fluid conduit” encompasses the end components 8, the longitudinal conduit 15, and the tubular connector 31 of joining piece 30. The tubular connector 31 and the end components 8 are structural support elements, and thus would be made from a material suitable to snap-fitting and providing structural integrity. In contrast, longitudinal conduit 15 is made from a material that may be crushed. As evident from the cross-hatching in Fig. 5, these components are made from different materials owing to their different functions. The Office Action supplies no evidence whatsoever to support a conclusion that the functions of the tubular connector 31, end components 8, and longitudinal conduit 15 can be formed together as an integral component and still retain their functionality, or one that these components can be formed of a resilient material. To do so certainly would not have been an obvious engineering design choice. The rejection should be withdrawn.

The Rejection of Claims 3, 4, 25 and 26 Should Be Withdrawn

Claims 3, 4, 25, and 26 depend from independent Claim 1. The Office Action relies upon the combination Marie, Nettekoven, and Moutafis to reject Claims 3, 4, 25, and 26. However, Moutafis does not cure the deficiencies noted above with respect to independent Claim 1.

Accordingly, the rejection of Claims 3, 4, 25, and 26 should be withdrawn at least for the reasons discussed above in connection with Claim 1.

The Rejection of Independent Claim 15 and Its Dependent Claims

While Applicants traverse the rejection of Claim 15 and its dependent claims, Applicants have amended Claim 15 without prejudice or disclaimer.¹ Claim 15 is patentable over the prior art of record. For reasons similar to those discussed above, Marie and Nettekoven fail to disclose, among other things, a valve having “a removable cap that connects the first and second housing portions.” These references also fail to disclose the claimed “flexible fluid conduit.” At least for these reasons, the rejection should be withdrawn and Claim 15 and its dependent claims allowed.

The Rejection of Independent Claim 28

While Applicants traverse the rejection of Claim 28, Applicants have amended Claim 28 without prejudice or disclaimer as above with respect to Claim 15. Claim 15 is patentable over the prior art of record. For the reasons discussed above, Marie and Nettekoven fail to disclose a valve having a “removable cap” as recited in Claim 28. Likewise, Marie and Nettekoven fail to disclose “resilient tubing removably held by the valve housing, the tubing coupled to the aspiration syringe and the cannula.” Norelli fails to make up for these deficiencies.

Applicants further note that neither Marie nor Nettekoven disclose “an aspiration syringe” as recited in Claim 28. The Office Action relies upon Norelli for an aspiration syringe. However, this reliance is misplaced. Norelli discloses a syringe with a safety cover. The syringe barrel is not sized or adapted in any way to couple to the aspiration/irrigation devices disclosed by Marie and Nettekoven. Rather, the syringe barrel connects to a needle safety cover. The

¹ Applicants specifically reserve the right to present claims of equal or broader scope in the pending continuing application.

proposed combination of Marie and Nettekoven with Norelli is the product of impermissible hindsight.


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This is the sixth non-final Office Action received in connection with the present application. The present application had been allowed, the issue fee paid, and a new continuation application filed to prosecute broader aspects of the invention. The provisional rejections and objections of the fifth non-final Office Action are believed to have been obviated and the present application is believed to be in condition for allowance.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. §1.1 36(a)(3).

Respectfully submitted,

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Dated: February 5, 2009

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